REMARKS

Claims 1-33 were pending in this application when the present Final Office Action was mailed (August 11, 2005) and a Notice of Appeal was filed (December 12, 2005). In this response, claims 1, 3, 5, 6, 11, 13, 14, 16, 17, 19, and 21 have been amended, and claims 22-33 have been canceled. Claims 34-37 have been added. Accordingly, claims 1-21 and 34-37 are currently pending.

In the August 11, 2005 Final Office Action, all the pending claims were rejected. More specifically, the status of the application in light of this Office Action is as follows:

(A) Claims 1-29 were rejected under 35 U.S.C. § 101;

(B) Claims 22, 23, 25 and 26 were rejected under 35 U.S.C. § 102(a) as being anticipated by "Polytechnic University, Notebook Computer Lease Agreement, Fall 2000" (the "Lease Agreement");

(C) Claims 32 and 33 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,013,897 to Harman et al. ("Harman");

(D) Claims 1-21, 24 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lease Agreement;

(E) Claims 30 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lease Agreement in view of Harman; and

(F) Claims 21 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lease Agreement in view of an article titled "Keeping a Roof Overhead" (the "Roof Overhead reference").

A. Response to the Section 101 Rejection

Claims 1-29 were rejected under 35 U.S.C. § 101. Specifically, the Examiner stated:

The basis of this rejection is set forth in a two prong test of:

> 1. Whether the invention is within the technological arts; and
>
> 2. Whether the invention produces a useful, concrete, and tangible result.
>
> For a claimed invention to be statutory, the claimed invention must be within the technological arts.

(Office Action, p. 2.)

The Board of Patent Appeals and Interferences has recently held that "there is no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101." (*Ex parte Lundgren*, Appeal No. 2003-2088 (BPAI 2005)). Therefore, even though applicant disagrees with Examiner as to whether the claims meet a "technological arts" test, since there is no such test, the point is moot.

B. Response to the Section 102(a) Rejection Over the Lease Agreement

Claims 22, 23, 25 and 26 were rejected under 35 U.S.C. § 102(a) as being anticipated by the Lease Agreement. Claims 22, 23, 25, and 26 have been canceled without commenting on or conceding the merits of the Examiner's position, and without prejudice to pursuing these claims in a continuation or other application. As a result, the Section 102(a) rejections of these claims are now moot.

C. Response to the Section 102(b) Rejection Over Harman

Claims 32 and 33 were rejected under 35 U.S.C. § 102(b) as being anticipated by Harman. Claims 32 and 33 have been canceled without commenting on or conceding the merits of the Examiner's position, and without prejudice to pursuing these claims in a continuation or other application. As a result, the Section 102(b) rejections of these claims are now moot.

D. Response to the Section 103(a) Rejection Over the Lease Agreement

Claims 1-21, 24 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lease Agreement. Claims 24 and 27-29 have been canceled without commenting on or conceding the merits of the Examiner's position, and without

prejudice to pursuing these claims in a continuation or other application, and so the Section 103(a) rejections of these claims are moot. The following discussion addresses the rejections of claims 1-21. For the reasons described below, the Lease Agreement does not support a *prima facie* case of obviousness with regard to claims 1-21.

Claim 1, as amended, is directed to method in a computer system for providing computer equipment to a customer. The method includes updating a database to indicate a lease of at least one computer component from a vendor. The lease provides for an assembler to receive the leased computer component from the vendor and pay the vendor a periodic vendor payment. The method also includes receiving an indication of an available piece of the computer equipment that is assembled by the assembler with the leased computer component. The method further includes: updating a database to indicate a lease of the assembled computer equipment from the assembler to the customer in return for a payment from the customer corresponding at least in part to a length of time the customer leases the computer equipment; receiving an indication from the customer that the lease is voluntarily terminated after an arbitrary, customer-selected time period has elapsed, without incurring a penalty to the customer; and updating the database to indicate that the computer equipment is received back from the customer.

The Lease Agreement discloses terms and conditions for students of the University to lease computers from the University. The terms include the following provision: "[f]ailure to enter into the notebook computer lease could have an adverse effect on your academic standing, as use of the notebook computer is essential to successful academic participation at the University." After a student graduates from the University and makes the final lease payment, the student has the option of purchasing the notebook computer from the University for one dollar. If a student prematurely departs from the University, the student must immediately return the notebook computer to the Help Desk.

Claim 1 is allowable over the Lease Agreement because the Lease Agreement fails to teach or suggest each and every feature of claim 1. For example, the Lease Agreement does not disclose "updating a database to indicate a lease of at least one

computer component from a vendor," and "receiving an indication of an available piece of computer equipment that is assembled by the assembler with the leased computer component". Assuming, for the sake of argument, that the computers of the Lease Agreement correspond, at least in part, to the computer equipment of claim 1, the Lease Agreement does not disclose that the University leases the components of the computers and assembles them into computers. Instead, as the Examiner recognizes, the University can either purchase or lease the computers from some other entity (Office Action, p. 6). However, leasing computers does not anticipate leasing computer components and assembling the leased components into computers. Moreover, there is no suggestion or motivation to modify the Lease Agreement for such an arrangement because the University's main mission is to provide educational services, not to manufacture computers.

Accordingly, the cited reference does not support a *prima facie* case of obviousness with regard to claim 1, and so the Section 103(a) rejection of claim 1 should be withdrawn. Claims 2-10 depend from claim 1. Accordingly, the Section 103(a) rejections of these claims based on the Lease Agreement should be withdrawn for the foregoing reasons discussed above and for the additional features of these dependent claims.

Claim 11 has been amended to include subject matter generally similar to that of claim 1. As a result, the Section 103(a) rejection based on the Lease Agreement should be withdrawn for the foregoing reasons discussed above and for the additional features of claim 11. Claims 12-15 depend from claim 11. Accordingly, the Section 103(a) rejections of these claims based on the Lease Agreement should be withdrawn for the foregoing reasons discussed above and for the additional features of these dependent claims.

Claim 16 has been amended to contain subject matter generally similar to that of claim 1. As a result, the Section 103(a) rejection based on the Lease Agreement should be withdrawn for the foregoing reasons discussed above and for the additional features of claim 16. Claims 17 and 18 depend from claim 16. Accordingly, the Section 103(a) rejections of these claims based on the Lease Agreement should be withdrawn

for the foregoing reasons discussed above and for the additional features of these dependent claims.

Claim 19 has been amended to include subject matter generally similar to that of claim 1. As a result, the Section 103(a) rejection based on the Lease Agreement should be withdrawn for the foregoing reasons discussed above and for the additional features of claim 19. Claims 20 and 22 depend from claim 19. Accordingly, the Section 103(a) rejections of these claims based on the Lease Agreement should be withdrawn for the foregoing reasons discussed above and for the additional features of these dependent claims.

E. Response to the Section 103(a) Rejection Over the Lease Agreement and Harman

Claims 30 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lease Agreement and Harman. Claims 30 and 31 have been canceled without commenting on or conceding the merits of the Examiner's position, and without prejudice to pursuing these claims in a continuation or other application. As a result, the Section 103(a) rejections of these claims are now moot.

F. Response to the Section 103(a) Rejection Over the Lease Agreement and Roof Overhead

Claims 21 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lease Agreement in view of the Roof Overhead reference. Claim 28 has been canceled without commenting on or conceding the merits of the Examiner's position, and without prejudice to pursuing these claims in a continuation or other application, so the rejection of claim 28 is now moot. As discussed above, the Lease Agreement fails to teach or suggest at least one feature of claim 19, and the Roof Overhead reference fails to fill this void. As a result, claim 21 is allowable over the combined teachings in the Lease Agreement and the Roof Overhead reference because claim 21 depends from claim 19, and also because claim 21 contains additional features. Accordingly, the Section 103(a) rejection of claim 21 should be withdrawn.

G. Newly Added Claims

Claims 34-37 have been added in this response. Claim 34 contains subject matter generally similar to that of claim 1, and so claim 34 is allowable over the cited references. Claims 35-37 depend from claim 34 and so are also allowable over the cited references for the foregoing reasons discussed above, and the additional features of these dependent claims.

H. Conclusion

In view of the foregoing, the claims pending in the application patentably define over the applied references. A Notice of Allowance is, therefore, respectfully requested. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned representative at (206) 359-3257.

Respectfully submitted,
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